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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Kreider et al.

Atty. Docket No.: PF115P4C1D1

Application No.: 10 054,967

Group Art Unit: 1646

Filed: January 25, 2002

Examiner: E. Kemmerer

For: Methods of Using Chemokine Beta-6

PROVISIONAL ELECTION UNDER 37 C.F.R. § 1.143 WITH TRAVERSE

Mail Stop Non-Fee Amendment
Commissioner for Patents
Washington, D.C. 20231

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Sir:

In response to the Office Action mailed March 11, 2003 (Paper No. 8), please consider the following provisional election, traversal, and remarks. Applicants submit a Fee Transmittal Sheet concurrently herewith. Claims 41-230 are pending.

The Restriction Requirement

Pursuant to Paper No. 8, mailed March 11, 2003, the Examiner has required an election under 35 U.S.C. § 121 of one of Groups I or II. The Examiner contends that the inventions are distinct, each from the other.

In response, Applicants provisionally elect, *with traverse*, the invention of Group I, represented by claims 41-135, drawn to methods of inhibiting activation or mobilization of eosinophils comprising administering a polypeptide comprising at least SEQ ID NO:23, for further prosecution. Applicants reserve the right to file one or more divisional applications directed to non-elected inventions should the restriction requirement be made final.

With respect to the Examiner's division of the invention into two groups and the reasons stated therefor, Applicants respectfully disagree and traverse. Applicants point out that even where patentably distinct inventions appear in a single application, restriction

remains improper unless the examiner can show that the search and examination of these groups would entail a "serious burden". See M.P.E.P. § 803. In the present situation, no such showing has been made. Instead, the Examiner has argued that "the art recognizes that eosinophils and basophils are significantly different," citing a medical dictionary, and therefore, "the patient populations for which the two inventions are useful are completely different, warranting a separate search." Paper No. 8, pages 2-3.

In response, Applicants disagree that either the difference between eosinophils and basophils, or the alleged difference in patient population between the two groups, renders the joint search and examination of the two Groups a serious burden. More particularly, since the concepts of patient population, eosinophil, and basophil are far too common to constitute an effective search, Applicants presume that the search will instead be focused on the polypeptide to be administered. As the methods of both Groups involve the administration of the same polypeptides, namely those comprising at least SEQ ID NO:23, such a search of the claims of either Group will include the results of both Groups. The Groups also have been classified in the same class and subclass, indicating that those of skill in the art consider the Groups highly related, if not indistinct. Moreover, while Applicants do not contest that there are differences between eosinophils and basophils, both cell types are polymorphonuclear leukocytes, and thus share many properties as well.

Accordingly, since the searches for the claims of both Groups should be nearly coextensive, and the Groups share the same classification and are directed to the same polypeptides, the combined search and examination of both Groups would not entail a serious burden. Thus, in view of M.P.E.P. § 803, the claims of both Groups I and II should be searched and examined in the present application, and Applicants respectfully request that the restriction requirement under 35 U.S.C. § 121 be reconsidered and withdrawn.

Applicants retain the right to petition from the restriction requirement under 37 C.F.R. § 1.144.

Conclusion

Entry of the above remarks is respectfully solicited. The Examiner is invited to call the undersigned at the phone number provided below if any further action by Applicant would expedite the examination of this application.

If there are any fees due in connection with the filing of this paper, please charge the fees to our Deposit Account No. 08-3425. If a fee is required for an extension of time under 37 C.F.R. § 1.136, such an extension is requested and the appropriate fee should also be charged to our Deposit Account.

Respectfully submitted,

Dated: April 11, 2003

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